

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

#24/Appeal
Brief
2/3

In re Application of: Glenn R. Godley)	Date:	March 5, 2004
Serial No.: 09/778,543)	Group Art Unit:	3714
Filed: 02/07/2001)	Examiner:	Sotomayor, John L.
Title: Vocal Training and Companionship Apparatus)		

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Terry Lakos
Name: TERRY LAKOS

3-5-04
Date

BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is an appeal from the Final Rejection, dated December 15, 2003 for the above identified application.

REAL PARTY IN INTEREST

The real parties of interest in this appeal is OurPet's Corporation, and Ohio company and assignee of the rights to the present technology, and who has commercialized products based thereon.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATEMENT OF AMENDMENTS

There have been no supplemental amendments filed after final rejection.

SUMMARY OF INVENTION

Referring now to **FIG. 1** through **FIG. 6** and the specification page 6, line 4 through page 11, line 9, a preferred recordable training device **10** for use with a bird is described in accordance with a preferred embodiment of the present invention. The training device **10** includes a reflecting mirror **12**, allowing the bird to view its own reflection, thereby providing the bird with a sense of companionship. However, pictures such as those of another bird, or other stimulation device could be used in lieu of the mirror **12**. Sensor **14** detects the presence of the bird and initiates the playback of a prerecorded voice or sound message recorded by the bird's owner or trainer.

One preferred sensor **14** is a motion sensor, whereby the movement of the bird will initiate the playback of the prerecorded message. Further embodiments are contemplated for the sensor **14**, such as a light sensor, which is activated when light is cut off from the sensor as a result of the bird's proximity to the training device **10**. A

heat sensor may also be used whereby the heat of the bird's body activates the sensor **14** and initiates the playback of the prerecorded message. A laser and laser-sensing device could also be utilized, whereby the bird's presence near the training device **10** would block the laser beam, thereby initiating the playback of the prerecorded message. The mirror **12** and sensor **14** are encased in a polypropylene frame **16**, however materials such as plastic or metal may be used.

Perch assembly **18** contains left **22** and right **24** members, which support the bird's perch **20**. The opening **30** of perch assembly **18**, as shown in **FIG. 3** allows the perch assembly **18** to connect the base **28** of training device **10** as shown in **FIG. 2**, by a snap fit, screws, press fit, or any other suitable means known by one with ordinary skill in the art. However, this perch assembly **18** may be integrated into the design of the housing **16** without being a separate piece. By connecting the perch assembly **18** to the base **28** of the training device **10**, a fully integrated bird perch is created. The perch **20** allows the bird to be in close proximity with the training device **10** and sensor **14**. Because the bird is in close proximity to the sensor **14** accurate playback is initiated only by the bird's movement not by collateral external activity. In addition, the present invention has the option of not using the perch assembly **18** in conjunction with base **28** of the training device **10**. Furthermore, the present invention **10** may include a seed or water trough **26** that can be inserted into the void (open space) **31** created by the perch assembly **18**, as shown in **FIG. 3**.

FIG. 4 illustrates the reverse side of the training device **10**. The present invention **10** includes a battery cover **32**, which is slideably removed for gaining access

to a battery compartment. To position or mount the training device **10**, the device may be oriented so that it simply sits on a floor or table, or other surface. Furthermore, the training device can be affixed in a desired position using a common means of attachment such as a bracket, adhesives, loop and hook, or any other suitable means known by one of ordinary skill in the art. In this embodiment, the training device **10**, mounting pins **36**, **38**, **40**, **42** and threaded pin **44** of the training mirror **10** are positioned through the bars of the bird's cage. A mounting plate **34** as shown in **FIG. 5** is arranged so that the mounting plate holes **70**, **72**, **74**, **76**, and **78** allow the mounting pins **36**, **38**, **40**, **42**, and threaded pin **44** of training device **10** to pass through. To secure the training mirror **10**, a thumb wheel **46** is threaded onto threaded pin **44**. By tightening the thumb wheel **46**, a compressive force is created by the mounting plate **34** and the training device **10** against the birdcage, thereby holding the training device **10** in the desired position.

To prepare the present invention **10** for use, the on/off switch **50** is put into the "ON" position. By putting the on/off switch **50** into the "ON" position, the present invention **10** is both ready to record and ready to detect the presence of the bird. Next, to record a message, the record button **58** is depressed, which illuminates an LED light **52** indicating that the training device **10** is ready to record a message. While continuing to depress the record button **58**, the user records the desired sound that he or she wishes the bird to learn while speaking into the microphone **54**. This phrase or message may be comprised of a song, whistles, the trainer's own voice, or any other audible sound that the trainer desires the bird to emulate. However, the training device

10 could be designed to record and playback sounds that are not audible to humans but are recognizable by animals such as birds. The user is given a predetermined amount of time in which a message can be recorded. If the user attempts to record a message that is longer than the specified limit, the LED indicator **52** will stop illuminating and the recording function will stop. In the event that the user elects to record a phrase that is shorter than the device's maximum time limit, the user, may release the record button **58** to stop the recording process at the desired point.

Once the recording process is completed the message is stored by the invention's memory, and the user may replay it by depressing the play button **56**. Once the play button **56** is depressed, the playback speaker **48** transmits the playback. By playing back the recorded message, the user can test the clarity and volume of the recorded sound. After the message is recorded, the training device **10** is ready for use, and playback of the prerecorded message will be initiated when the sensor **14** detects the presence of the bird near the training mirror **10**. By putting the on/off switch **50** into the "OFF" position, the recording and playback feature of the training device **10** is made inoperable. To erase a previous recorded message, the owner simply re-records a new message by depressing and holding the record button **58**, which initiates the aforementioned recording sequence. A preferred embodiment which does not include the perch assembly **18** and trough **26** is suitable for applications for training subjects such as animals and children.

Further embodiments of the present invention **10** may be comprised of a playback system without a recording feature. The playback system would contain

prerecorded phrases, whistles, or any other sound that is audible to an animal or human. A selector switch may then be used to choose the desired message to be played. Also, a volume control feature is contemplated wherein the sound output level of the training device **10** may be reduced or increased via a volume control.

Additionally, a system that would increase or decrease the frequency in which the recorded sound is played back independently of the detection by the sensor **14** is also contemplated.

The preferred embodiment illustrated in **FIG. 6** describes a training device **10** that can be used for subjects such as animals or children in general. This preferred embodiment of the present invention **10** is identical to the aforementioned preferred embodiment, which is used for a bird, with the exception of the bird perch assembly **18**, which is unnecessary. Specifically, training device **10** contains a mirror **12** that provides an incentive for the subject to engage in interacting with the training device **10**. However, a picture of the child's mother or father, picture of another animal, or other type of comforting image may be substituted in place of the training device's mirror **10**. A sensing device **14** is used to detect the presence or absence of the subject and to initiate the playback of the recorded sound. To mount the training device **10**, any typical means of attachment such as adhesives, hook and loop, or any other type of attachment means known by one skilled in the art may be used. Furthermore, the training device **10** is capable of freely standing alone in a desired position without the need of any attachment or mounting means.

ISSUES

The issues on appeal include:

- (a) Are Claims 1, 2, 4-5, 9-12, 15, 18 and 19 anticipated by Hicks under 35 U.S.C. § 102(b)?
- (b) Are Claims 1, 4-6 and 18 anticipated by Yu under 35 U.S.C. § 102(b)?
- (c) Are Claims 6-8 unpatentable over Hicks under 35 U.S.C. § 103(a)?
- (d) Are Claims 13-14 unpatentable over Hicks in view of Whitaker under 35 U.S.C. § 103(a)?
- (e) Are Claims 16 unpatentable over Hicks in view of Manico et al. under 35 U.S.C. § 103(a)?

GROUPING OF CLAIMS

Each remaining claims forms a single group of claims that stands or fall independent of the others.

ARGUMENT

1. Rejections Under 35 U.S.C. § 102(b)

In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(b), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2

USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

- (a) The examiner respectfully rejected Claims 1, 2, 4-5, 9-12, 15, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hicks.

The examiner cited Hicks as disclosing a sensor for detecting the presence of a subject and a housing containing the sensor. However, what is disclosed in Hicks is not a sensor but a mechanical lever sensitive to the weight of a bird. As such, Hicks fails to disclose every element of Claims 1 and 18 as required, thus Claims 1 and 18 are considered allowable. And, because Claims 2, 4-5, 9-12 and 15 depend from Claim 1, Claims 2, 4-5, 9-12 and 15 are also considered allowable.

In regard to Claims 9 and 10, specifically, the invention as disclosed by Hicks includes a perch that is detachable. However, the perch is used to activate the prerecorded message once a bird activates the playback via the weight sensitive perch. If the perch is removed (because it is detachable), it fails to operate and anticipate the present invention as claimed. As such, Claims 9 and 10 are further considered allowable.

- (b) The examiner respectfully rejected Claims 1, 4-6 and 18 under 35 U.S.C. § 102(b) as being anticipated by Yu.

The Yu reference discloses a lighting fixture with *motion* detector and announcement device, wherein a person or object entering into a monitored area triggers the announcement device to deliver a prerecorded message.

In contrast, the present invention claims a *presence* detector and initiation of

playback of the prerecorded message based on the *presence* of an object. Motion is distinct from presence, as the mere presence of an object in an area would not necessarily trigger the motion detector. Conversely, mere motion would not trigger the presence detector. Therefore, a distinct difference exists between the motion detector claimed in Yu and the presence detector in Claim 1 of the present invention.

Because Yu fails to disclose every element of Claim 1, and dependent Claims 4-6, and Claim 18, the Examiner's rejection of Claims 1, 4-6 and 18 is inappropriate.

2. Rejections under 35 U.S.C. 103(a)

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j).

- (a) The examiner respectfully rejected Claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Hicks.

Claims 6-8 disclose different presence detecting sensors, one having a light sensing device, one having a laser and laser detection sensor and a heat sensing device, respectively. The examiner has admitted that Hicks fails to specifically disclose these different presence detectors, yet still rejects Claims 6-8 as unpatentable based on obviousness to one of ordinary skill in the art. The applicant feels that the examiner has failed to meet the evidentiary burden required by providing evidence that the claimed elements and/or features are disclosed, taught, suggested and/or claimed by the prior art cited. Failure to meet this burden is indicative of the patentability of the

claims in question, and as such, Claims 6-8 are considered allowable.

- (b) The examiner respectfully rejected Claims 13-14 under 35 U.S.C. § 103(a) as being unpatentable over Hicks in view of Whitaker.

Whitaker is cited in combination with Hicks as disclosing every element of Claims 13 and 14. However, Whitaker discloses clips and hook and loop material for attaching the device to a bird cage. The present invention discloses brackets, which are different in mechanics and function to more securely hold a device in place (in comparison to clips and/or hook-loop material). As such, every element of Claims 13 and 14 are not disclosed, taught, suggested or claimed by the combination of Hicks and Whitaker, therefore Claims 13 and 14 are considered allowable.

- (c) The examiner respectfully rejected Claims 16 under 35 U.S.C. § 103(a) as being unpatentable over Hicks in view of Manico et al.

The combination of Hicks and Manico et al. appears to render the combination inoperable, since the trough from Manico et al. would be inserted between the weight sensitive perch of Hicks. Either the perch would have to fixed or the trough would be subject to the up and down movement of the perch, and thus subject to spillage of its contents and potential damage. As such, the combination appears to teach away from one another, and would appear to teach away from the present invention. As such, every element of Claim 16 is not disclosed, taught, suggested or claimed by the combination of Hicks and Manico et al., thus Claim 16 is considered allowable.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate.

However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

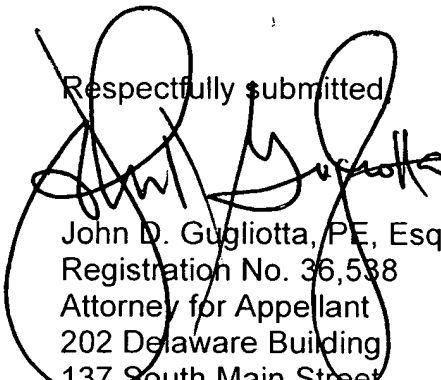
There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a vocal training apparatus having a presence detector and a playback system based on the actuation of the presence detector. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d

1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,



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APPENDIX

THE CLAIMS ON APPEAL

The claims on appeal are as follows:

1. An apparatus to teach a subject to vocally emulate sounds comprising:
a presence detecting sensor for detecting the presence of a subject;
a system for playing back a predetermined message, wherein said system initiates playback of said predetermined message upon detection of the presence of said subject by said presence detecting sensor; and
a housing which contains said sensor and said playback initiation system.
2. An apparatus as recited in claim 1 further comprising a system for selecting a prerecorded sound to be played, wherein said system comprises a selector switch for choosing a desired prerecorded sound.
3. Canceled.
4. An apparatus as recited in claim 1 further comprising a system for recording sounds that are audible to animals.
5. An apparatus as recited in claim 1 wherein said presence detecting sensor comprises a movement sensing device.

6. An apparatus as recited in claim 1 wherein said presence detecting sensor comprises a light sensing device for detecting the absence of light due to the presence of said subject.
7. An apparatus as recited in claim 1 wherein said presence detecting sensor comprises a laser and a laser detection sensor.
8. An apparatus as recited in claim 1 wherein said presence detecting sensor for detecting the presence of said subject comprises a heat sensing device.
9. An apparatus as recited in claim 1, further comprising a bird perch, said bird perch for holding said subject, said subject being a bird.
10. An apparatus as recited in claim 9, wherein said bird perch is detachable.
11. An apparatus as recited in claim 1, further comprising a mirror.
12. An apparatus as recited in claim 11, wherein said mirror is contained within said housing, said mirror providing visual stimulation to said subject.
13. An apparatus as recited in claim 1, further comprising a means for attaching said apparatus to a birdcage.

14. An apparatus as recited in claim 13 wherein, said means for attaching said apparatus to said birdcage comprises a bracket.
15. An apparatus as recited in claim 1 wherein, said apparatus is capable of freely standing.
16. An apparatus as recited in claim 9 further comprising a trough, wherein said trough is inserted within a space formed within said bird perch.
17. Canceled.
18. A method of teaching a subject to vocalize sounds comprising:
 - selecting a prerecorded sound to be played back by a playback system;
 - detecting said subject's presence by a presence detecting sensor; and
 - upon the sensor's detection of said subject, the prerecorded sound is played back for said subject to hear, whereby said subject learns to vocally emulate a desired sound.
19. An apparatus to teach a subject to vocally emulate sounds comprising:
 - a housing, said housing comprising an front portion and a back portion;
 - a presence detecting sensor, said presence detecting sensor located at said front portion for detecting the presence of said subject;
 - a system for playing back a predetermined message, said system located at said

back portion, and wherein said system initiates playback of said predetermined message upon detection of the presence of said subject by said presence detecting sensor;

a mirror, said mirror affixed to said front portion; and

a perch assembly, said perch assembly coupled to a lower portion of said housing.